REMARKS

Claims 1-59 are currently pending in the application, with claims 23-32 and 34-59 having been provisionally original from consideration in response to a restriction requirement and election. Claims 1 and 9 have been amended and claims 60 and 61 have been added for the Examiner's consideration. Previously original claims 23-32 have been amended to properly depend from claim 9 and are believed to be allowable if claim 9 is allowable. Further, previously original independent claims 34, 40 and 56 have been amended to more fully claim the invention as described in claims 1 and 9, with corresponding conforming amendments to claims 35, 41 and 57. Previously original claims 49-54 have been amended to properly depend from claim 40, so as to be allowable if claim 40 is allowable, and previously original claims 58 and 59 have been amended to properly depend from claim 56, so as to be allowable if claim 56 is allowable. Formerly original claims not currently amended are in their original form and that status is so indicated. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, with an indication of the current status of each .

It is noted that the Examiner has not renewed his previous objection to the "reference signs" in figures 2-6, there having been provided an additional paragraph to the specification making explicit the function of these drawing interconnection symbols. This is acknowledged with appreciation. It is requested that an indication of acceptance of the drawings be provided in the next office action.

The Examiner has objected to claim 2, and indicates that claim 2 must be amended to insert the word – trial – after "previous" in line 3. This objection is discussed hereafter in connection with the Examiner's §112 rejection of claim 2.

The Examiner has objected to the specification as failing to provide proper antecedent basis for "means for determining" in line 8 of claim 9. The present amendment provides express reference to "computer means" and to a database for recordation of prior uses of the trial purchase procedure. See the discussion below regarding the Examiner's §112 rejection for argument that the specification and

figures provide sufficient antecedent basis to one skilled in the art for a software implementation of "computer means for determining."

The Examiner has raised for the first time a rejection of claims 1-8 under 35 U.S.C. §101 as directed to non-statutory subject matter. In particular, the Examiner asserts that the limitation "determining whether or not the user has already performed a trial purchase procedure" is a mere abstract idea lacking technology for establishing the usefulness of the invention. The Examiner suggests that recitation of a computer, or a database, or a computer readable medium is required for the step to be useful. The present amendment follows this suggestion, and it is therefore believed this ground of rejection is overcome.

The Examiner maintains rejection of claims 9-22 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement on the ground that the claim language does not suitably identify structure for performing the invention. Otherwise, according to the Examiner, the "means for determining" (as well as "means for performing" and "means for notifying") could be a step performed by a person mentally or on paper. Clearly, the invention as described in the specification contemplates a computer implementation of these various structures. The necessary means are evident in the specification and drawings to one skilled in the art. For example, the "means for determining" in line 8 is described in the specification at page 12, lines 16-20, and in the flow chart described in Figures 2-6. A journeyman programmer would be able to implement the "means for determining" from the disclosure in the specification and flow chart. In accordance with the specification and drawings, the structure would be imbedded in software, portions of which are resident on the terminal 1-1 and other portions of which comprise the selling system 3.

The Examiner acknowledges that the structure would be imbedded in software, but notes that the drawings show not "structure but logical steps." However, as is well understood in the art, software structures for performance on a computer are conventionally expressed as logical steps in a flow chart. Indeed, software specifications commonly include flow charts in order to show how the software structures operate. For example, the "means for determining" shown in the

flow chart of Figures 2-6 are conventional expressions of corresponding software structures, and would be so interpreted by those skilled in the art. See the paragraph below for a detailed description of how these figures are interpreted by those skilled in the art. The Examiner suggests that the claim language itself, however, does not exclude the possibility that "means for determining" could be performed "mentally or on paper," and further suggests therefore that "means for determining" is not useful without "associating it with a computer to provide a tangible result." Since a computer implementation is clearly the intention of the specification as it would be understood by those skilled in the art, the Examiner's suggestion has been followed in this amendment

The meaning of Figures 2-6, as understood by one skilled in the art, will now be described in detail with respect to how the desired information comes to be stored in the customer information database 5. It will be observed that a user at a terminal is either a member or not a member. At the user's earliest contact with the system, prior to considering membership, the user would not have been a member and will access a trial purchase page at S1 (on Figure 2), completing the information for a trial purchase at S16 after interaction via S5 with commodity information database 4. From there the user will move to S17 (on Figure 3), and because he is not yet a member the user is diverted to S28 (on Figure 4) and then through S29, S34, S35 (all on Figure 4) and then to S36 (on Figure 5) where storage of customer information in the customer information database 5 is confirmed and the ID/password is issued, whereupon the user is returned to S30 (on Figure 4) for entry of the ID/password, which is checked at S32, whereupon the user is returned to S18 (on Figure 4). At this point, the structure implementing the segment of the flow chart beginning at S20 completes performance of the trial purchase procedure for the user, in accordance with the "means for performing" element of the invention. At S21 the customer information is displayed along with the contents of the trial purchase order. It is to be noted from Figure 1 that both the commodity information database and the customer information database are available to the selling system, and that one skilled in the art would understand that prior use of the system by the user would be stored and would be available to the selling system via the customer information database. When the

contents of the trial purchase order is correct and not further to be changed the user goes to S23 and S24. As described at page 13, lines 19-26, since this is a trial purchase there will be no selection of a payment method because the commodities are free of charge. Thereafter, however, when this user enters the system again at S1, reaches a purchase determination at S16, and then reaches S18, the fact of the prior trial purchase is available via the customer information database 5, and the user will be diverted to S19. Implementation of this diversion within the trial purchase system (and in particular within selling system 3 as shown in Figure 3) coupled with display at S19 (within the terminal 1-1 as shown in Figure 3) constitutes the "means for notifying" structure in accordance with the invention.

It should be evident that similar detailed descriptions, drawn from the same figures, apply to "means for performing ... the purchase procedure" in lines 10-11, and "means for notifying the user ... that the trial purchase procedure cannot be provided" in lines 12-13. It should also be noted that the invention must be understood in the context of both the figures and the specification. It should further be evident that while the figures themselves provide sufficient detail for a software implementation, one skilled in the art would be able to modify these details in accordance with the import of the specification. For example, it is consistent with the specification that a system according to the invention might provide more than one trial purchase (see page 13, line 1-2) even though the embodiment shown in the figures provides only one trial purchase (see page 10, lines 2-5; page 11, lines 1-3; page 12, lines 22-23). It is also consistent with the specification for the trial purchase system to be limited not by the number of trial purchases but by a predetermined sum of money (see page 9, lines 1-4). One skilled in the art would be able suitably to adapt a software implementation to provide more than one trial purchase or to require a method of payment for amounts in excess of a predetermined sum. Similarly, while the embodiment shown in the figures provides a trial purchase service to members, another embodiment might not provide such a service to members (see page 12, lines 8-15). Also, it will be understood by those skilled in the art that it is possible, within the terms of the invention, for a user to make a purchase as a member without

triggering the trial purchase option, because commodities are limited to commodities for trial purchase (see page 8, lines 17-18).

In all such implementations of the invention, however, the characteristics described in the claims remain, namely, that the invention detects whether a user has previously used the trial purchase service, and this information is used to determine whether a subsequent use of the trial purchase service is available. Consequently, claims 1 and 9 have been amended to broaden their scope beyond the example given in the figures to include the scope of the invention as described in the specifation.

In light of the foregoing, we will now consider the Examiner's objection to claim 2 and rejection of claim 2 under §112, first paragraph. Claim 2 contains two elements. The first element provides for storing a delivery destination as a result of a previous purchase by the user. As will be understood from the foregoing amendment and discussion, such a previous purchase need not necessarily be a prior – trial – purchase. Thus it is appropriate that the existing language for this first element be preserved. It is believed that the Examiner's objection is thereby overcome. Similarly, with regard to the §112, first paragraph, rejection, there is no basis for this rejection since delivery of a trial purchase commodity is consistent with a prior purchase and delivery in several possible implementations of the invention. In one possible implementation the user has become a member and made a purchase of a commodity not available for trial purchase. For example, a company may implement the invention in such circumstances in order to provide incentives for a return visit by a member who might not otherwise return. In another possible implementation, a company may implement the invention so as to provide for more than one trial purchase, in which case a trial purchase delivery will be available even though a prior trial purchase delivery has occurred.

The Examiner has rejected claims 1 and 2 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,571,216 to Garg et al. Claims 3 and 5-7 appear also to be rejected using Garg. Claims 9-22 and 33 are rejected as "inherently constructed" based on Garg. Garg discloses a methodology and system that allows a plurality of reward scheme owners to give differential rewards, through a plurality of reward distribution agents, to various users based on a user profile. The reward scheme

owner may be a seller, a manufacturer, a sales promotion agent or even an intermediary. Similarly, the reward distribution agent may be an on-line or a physical retailer, a broker, a seller or an intermediary. Also the users may be consumers, businesses, brokers or other intermediaries. In one specific case, a reward scheme owner defines a plurality of reward schemes, including at least one differential reward scheme giving different rewards to different users. The reward scheme owner communicates these to a central reward scheme database server. The reward scheme owners may or may not advertise these schemes. The user visits an online or a physical store. The store acting as a reward distribution agent dynamically profiles the user, queries the central reward scheme database server if the user profile meets the criterion for one or more rewards and offers the applicable rewards to the user. The store later receives reimbursement for the rewards offered to various users, from the reward scheme owners. This methodology and system may be used for offering targeted or differential discounts on different products and services, offering different promotional schemes on different combination of products, giving loyalty points, electronically distributing prizes, free samples, product warranties, tie-in promotions, cross selling, up selling, premiums, memberships, card discounts, organizing contests, sweepstakes, games and offering other similar rewards.

Garg discloses – as one of its strategies for responding to a user profile – the option of giving a free sample to the user. However, in the present invention the system makes a determination whether the user is eligible for a trial purchase procedure, and that determination is based upon records of prior use by the user of the system's commodity providing means, including whether the user has already been provided with the experience of a trial purchase procedure. It is clear that Garg fails to provide or suggest such an eligibility determination dependent on prior use, including prior use of the trial purchase experience. The Examiner attempts to fill that gap by asserting that the claims cover a first time user given a "freebie" by Garg, arguing therefore that the "conditioning" is inherent. However, this inherency argument is flawed because Garg fails to disclose a "freebie" without a user profile. For the Examiner's comparison between the present invention and Garg to make sense, there must be a correspondence between Garg's user profile and the present

invention's recordation of prior use of the commodity providing means, including use of the trial purchase procedure.

But this is inconsistent with the Examiner's inherency argument, which depends upon a correspondence between the lack of a prior use record in the present invention with giving a "freebie" to a new user without a user profile. Since Garg does not describe or suggest giving a "freebie" simply to a "new user"absent a user profile, it is clear that the Examiner's inherency argument must fail. Garg lacks the necessary connection between giving the "freebie" and the lack of a prior use record. Garg requires, as its justification for the "freebie", a user profile. By contrast, the present invention has no such requirement. Consequently, once this initial case (i.e. a "freebie" to a "new user") is distinguished, the Examiner's inherency argument evaporates and is no longer applicable.

Instead of a present and updated user profile (col. 7, lines 5-7) being the basis for a present reward, the present invention simply stores a record of a past use which then serves to condition a present use. It is because of this practice that the claimed step of "determining whether or not the user is eligible for a trial purchase procedure" has a significance unique to the present invention. Garg is concerned with user profiles which are the basis of targeted rewards (col. 7, lines 5-7). While "free samples" (col. 3, line 37) are mentioned by Garg within a list of promotional schemes for "targeted or differential discounts" (col. 3, line 34), Garg fails to make a connection limiting a user's access to a subsequent promotion based upon that user's participation in a past promotion. It is that connection which is made by the present invention. The Examiner cites a) the inherency argument and b) col. 12, lines 24-32, for this connection, but a1) as shown above the inherency argument fails because it is not factual (i.e. Garg provides a reward based on a user profile **NOT** based on being a "new user"), and b1) the cited passage from Garg describes an evaluation of whether the user presently has the profile targeted by the reward, **NOT** whether the user has obtained a "freebie" on a prior promotion. While such past usage information may be stored in a user's profile, there is no suggestion in Garg for using it in the manner claimed by the present invention.

The present invention is intended to overcome initial hesitance of a customer to use a web page for making purchases, by using the web page to distribute selected products for free (see page 13, line 26) or for a reduced charge and for limited quantities (see page 9, lines 1-4). The problem being addressed by the present invention is the contrast between the in-store purchase experience familiar to the user and the online experience (page 3, lines 10-13). The trial purchase commodity may be provided for pickup at the designated destination (page 4, line 17). The invention provides mechanisms to overcome first time customer hesitancy to engage in online purchase for reasons such as fear of paying for a commodity and not receiving it (page 3, lines 17-18) or not knowing whether or how or at what cost a commodity can be changed (page 3, lines 20-24). Since the invention is directed to new customers, provision is made in the invention for limiting the trial purchase opportunity to those who have not already performed a trial purchase (see step S18 in Figure 3), although a merchant may provide the trial purchase service more than once to the same customer (page 13, lines 1-2).

For the foregoing reasons it is evident that the present invention, as claimed in claims 1 and 9, is not anticipated by Garg and claims 1 and 9 are believed to be in allowable form. Since the remaining claims depend from claims 1 and 9, the §102 rejection is also overcome as to the remaining claims. This argument also applies to claims 4 and 8, which have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Garg in view of the StartSampling.Com publication. Consequently, it is submitted that claims 4 and 8 overcome the §103 rejection based on the allowability of claim 1.

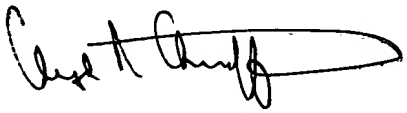
It is therefore submitted that the current amendments, including those which follow the suggestions of the Examiner to overcome the Examiner's §112, first paragraph, rejection, place the rejected claims and the original claims in condition for allowance.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1-22, 33 and 60-61 be allowed, that original claims 23-32 and 34-59 be brought back into the case and allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: clyde@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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